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EXAMINER	
TOLENTINO, RODERICK	

ART UNIT	PAPER NUMBER
2134	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/066,457	KUTARAGI ET AL.	
	Examiner	Art Unit	
	Roderick Tolentino	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 - 42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 - 42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1 – 42 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1 – 38, have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. As per claim 16, limitation recites checking to see if two unique pieces of information are the same. It is indefinite to the Examiner as to how this is possible. Unique by definition in any standard dictionary is said to be something that is one of a kind. Seeing if they are the same is not possible as how the claim now reads. Further in claim 16, limitation recites, "makes reference thereto." It is indefinite as to what exactly is being referenced by the information. For purposes examination the claim will be interpreted to disabling a medium from reading a program.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 6, 22 – 24 and 32 – 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Milsted et al. U.S. Patent No. (6,345,256).

7. As per claims 1 and 32, 34, 35 and 37, Milsted discloses a first information processing apparatus capable of being mounted with a first recording medium, and a second information processing apparatus capable of being connected to the first information processing apparatus via a network (Milsted, Col. 25 Lines 45 – 52), wherein the second information processing apparatus is operable to receive first unique information and second unique information, from the first information processing apparatus over the network, the first unique information relating to the first information processing apparatus and the second unique information relating to the first recording medium, the second information processing apparatus being further operable to make reference to each of the received first and second unique information and to third information to verify the first recording medium, the third information being stored in a database included in, or connected to the second information processing apparatus (Milsted, Col. 25 Lines 45 – 52).

8. As per claim 2, Milsted discloses the second information processing apparatus is operable to cause the database to store at least one of the first unique information or the second unique information (Milsted, Col. 25 Lines 45 – 52).

9. As per claim 3, Milsted discloses the second information processing apparatus is operable to cause the database to store both the first and second unique information (Milsted, Col. 25 Lines 19 – 24 and Lines 45 – 52).

10. As per claim 4, Milsted discloses at least one of the first unique information or the second unique information is stored in the database prior to when the second information processing apparatus receives the first unique information and the second unique information from the first processing apparatus, and the third information includes at least one of the first unique information stored in the database or the second unique information stored in the database (Milsted, Col. 25 Lines 19 – 24).

11. As per claim 5, Milsted discloses the third information includes the first unique information stored in the database and the second unique information stored in the database (Milsted, Col. 25 Lines 19 – 24 and Lines 45 – 52).

12. As per claim 6, Milsted discloses the second information processing apparatus is operable to cause updated third information to be stored in the database when the second information processing apparatus receives new information including at least one of the first unique information or the second unique information from the first information processing apparatus (Milsted, Col. 25 Lines 45 – 52).

13. As per claim 22, Milsted teaches the unique information relating to respective information processing apparatus is an apparatus ID (Milsted, Col. 25 Lines 45 – 52).

14. As per claim 23, Milsted teaches the unique information relating to respective information processing apparatus is a user ID (Milsted, Col. 79 Lines 5 – 12).

15. As per claim 24, Milsted teaches the unique information relating to respective recording medium is a recording medium ID (Milsted, Col. 25 Lines 45 – 52).

16. As per claims 33, 36 and 38, Milsted discloses the first information processing apparatus is capable of being loaded with a first recording medium and capable of being connected to a second information processing apparatus via a network, the first information processing apparatus being operable to transmit first unique information and second unique information (Milsted, Col. 23 Lines 55 – 61) to the second information processing apparatus, the first unique information relating to the first information processing apparatus and the second unique information relating to the first recording medium, the first information processing apparatus being operable to verify the first recording by making reference to each of the transmitted information and to third information stored in a database included in, or connected to, the second information processing apparatus (Milsted, Col. 25 Lines 45 – 52).

17. As per claims 39 – 42, Milsted teaches the second information processing apparatus is operable to determine whether the first recording medium is authorized for use when the second information processing apparatus verifies the first recording medium (Milsted, Col. 26 Lines 63 – 67, Col. 27 Lines 1 – 3 and Col. 29 Lines 11 – 22).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milsted et al. U.S. Patent No. (6,345,256) and in view of Conklin et al. U.S. Patent No. (5,991,881).

20. As per claim 7, Milsted fails to teach the second information processing apparatus is operable to cause at lease one of the first unique information or the second unique information to be stored in the database whenever unauthorized usage of the first recording medium occurs. However, in an analogous art Conklin teaches the second information processing apparatus is operable to cause at lease one of the first unique information or the second unique information to be stored in the database whenever unauthorized usage of the first recording medium occurs (Conklin, Col. 1 Lines 21 – 27).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Conklin's network surveillance system with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of collecting- evidence and report progress of any intrusions to the network (Conklin, Col. 1 Lines 51 – 53).

21. Claims 8 – 15, 19 – 21, 25 – 27 and 29 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milsted et al. U.S. Patent No. (6,345,256) in view of Kataoka et al. U.S. patent No. (5,857,021)

22. As per claims 8 and 9, Milsted fails to teach the second information processing apparatus operable to enable or disable processing to be performed in the first information processing apparatus. However, in an analogous are Kataoka teaches teach the second information processing apparatus operable to enable or disable processing to be performed in the first information processing apparatus (Kataoka, Col. 3 Lines 19 – 22).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of preventing any processing from being performed when no processing is needed at the time.

23. As per claim 10, Milsted teaches the second information processing apparatus is operable to transmit at least one of a permission signal for enabling the first information processing apparatus to perform processing or an inhibit signal for disabling the first information processing apparatus from performing processing (Milsted, Col. 26 Lines 63 – 67 and Col. 27 Lines 1 – 9).

24. As per claims 11 and 12, Milsted teaches the network system is operable to enable the first information processing apparatus to perform processing when the

results of the reference made by the second information processing apparatus indicates that the third information corresponds to the first unique information received from the first information processing apparatus (Milsted, Col. 26 Lines 63 – 67 and Col. 27 Lines 1 – 5).

25. As per claim 13, Milsted teaches the first information processing apparatus is operable to encrypt the program stored in the first recording medium and to store the encrypted program in the first recording medium (Milsted, Col. 25 Lines 53 – 60) and the second information processing apparatus is operable to transmit information for decrypting the encrypted program stored in the first recording medium to enable the first information processing apparatus to read and decrypt the encrypted program stored in the first recording medium (Milsted, Col. 26 Lines 63 – 67 and Col. 27 Lines 1 – 5).

26. As per claim 14, Milsted teaches the information for decrypting includes a decryption key (Milsted, Col. 27 Lines 15 – 17).

27. As per claim 15, Milsted fails to teach the network system is connected to a third information processing apparatus capable of being mounted with a second recording medium different from the first recording medium, and wherein the second information processing apparatus is operable to receive third unique information relating to the second recording medium from the third information processing apparatus, when the second information processing apparatus receives the second unique information from the first information processing apparatus. However, in an analogous art Kataoka teaches the network system is connected to a third information processing apparatus capable of being mounted with a second recording medium different from the first

recording medium, and wherein the second information processing apparatus is operable to receive third unique information relating to the second recording medium from the third information processing apparatus, when the second information processing apparatus receives the second unique information from the first information processing apparatus (Kataoka, Fig. 1 Item 10, plurality of branches, Col. 3 Lines 12 – 22).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of supervising data encryptions involving writing mediums (Kataoka, Col. 3 Lines 23 – 28).

28. As per claim 19, Milsted fails to teach the first information processing apparatus is further capable of being mounted with a third recording medium, and wherein the second information processing apparatus is operative to transmit the unique information relating to the first information processing apparatus and the unique information relating to the first recording medium, to the first information processing apparatus, after it has received each of said unique information from the first information processing apparatus, and then the first information processing apparatus enables the second recording medium to store each of the first unique information and the second unique information after the second information processing apparatus receives the first unique information and the second unique information. However, in an analogous art Kataoka

teaches the first information processing apparatus is further capable of being mounted with a third recording medium, and wherein the second information processing apparatus is operative to transmit the unique information relating to the first information processing apparatus and the unique information relating to the first recording medium, to the first information processing apparatus, after it has received each of said unique information from the first information processing apparatus, and then the first information processing apparatus enables the second recording medium to store each of the first unique information and the second unique information after the second information processing apparatus receives the first unique information and the second unique information. (Kataoka, Fig. 1 Item 10, plurality of storage mediums).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being a more secure way transmitting data between devices.

29. As per claim 20, Milsted teaches verification of recording mediums (Milsted, Col. 25 Lines 45 – 52) but fails to teach the first information processing apparatus makes reference to the unique information relating to the first recording medium as well as information stored in the third recording medium. However, in an analogous art Kataoka teaches the first information processing apparatus makes reference to the unique information relating to the first recording medium as well as information stored in the third recording medium (Kataoka, Col. 4 Lines 29 – 36).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being a more secure way transmitting data between devices.

30. As per claim 21, Milsted fails to teach the event that the results of the reference made by the first information processing apparatus indicates that information corresponding to the unique information relating to the first recording medium is stored in the third recording medium, then the processing to be performed by the first information processing apparatus is enabled. However, in an analogous art Kataoka teaches the event that the results of the reference made by the first information processing apparatus indicates that information corresponding to the unique information relating to the first recording medium is stored in the third recording medium, then the processing to be performed by the first information processing apparatus is enabled (Kataoka, Col. 4 Lines 29 – 36, Medium IDs).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to easily identify mediums through ids.

31. As per claim 25, Milsted fails to teach the recording medium storing the application programs is an optical disk, and the unique information relating to said

recording medium is a disk ID. However, in an analogous art Kataoka teaches the recording medium storing the application programs is an optical disk, and the unique information relating to said recording medium is a disk ID (Kataoka, Col. 3 Lines 29 – 34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to easily identify disk through ids.

32. As per claim 26, Milsted fails to teach the disk ID is recorded in a region within a data area or a region other than the data area of the optical disk. Howver, in an analogous art Kataoka teaches the disk ID is recorded in a region within a data area or a region other than the data area of the optical disk (Kataoka, Col. 3 Lines 42 – 47).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to easily identify disk through ids.

33. As per claim 27, Milsted fails to teach the disk ID is detected by a computer based on an address of disk ID data recorded in a data area of the optical disk. However, in an analogous art Kataoka teaches the disk ID is detected by a computer

based on an address of disk ID data recorded in a data area of the optical disk (Kataoka, Col. 3 Lines 29 – 34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to easily identify disk through ids.

34. As per claim 29, Milsted fails to teach the disk ID is formed with a method using physical changes in pit rows. However, in an analogous art Kataoka teaches the disk ID is formed with a method using physical changes in pit rows (Kataoka, Col. 3 Lines 42 – 47).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to easily identify disk through ids.

35. As per claim 30, Milsted fails to teach the method using physical changes in pit rows uses one of change in radical direction of pit rows, change in the minor axis direction of pit size, and change in the depth direction of pits. However, in an analogous art Kataoka teaches the method using physical changes in pit rows uses one of change in radical direction of pit rows, change in the minor axis direction of pit size, and change in the depth direction of pits (Kataoka, Col. 3 Lines 42 – 47).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to easily identify disk through ids.

36. As per claim 31, Milsted teaches electronic watermarking (Milsted, Col. 79 Lines 5 – 12), but fails to teach disk ID. However, in an analogous art Kataoka teaches disk ID (Kataoka, Col. 3 Lines 29 – 34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to easily identify disk through ids.

37. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milsted et al. U.S. Patent No. (6,345,256) and Kataoka et al. U.S. patent No. (5,857,021), as applied to claim 15 and in further view of Otsuka U.S. Patent No. (6,901,511).

38. As per claim 16, Milsted fails to teach the second information processing apparatus is operable to make reference to the first unique information and the third unique information and when the first and third unique information are the same when the second information processing apparatus makes reference thereto, the second information apparatus is operable to disable the third information processing apparatus

from reading a program stored in the second recording medium. However, in an analogous art Otsuka teaches the second information processing apparatus is operable to make reference to the first unique information and the third unique information and when the first and third unique information are the same when the second information processing apparatus makes reference thereto, the second information apparatus is operable to disable the third information processing apparatus from reading a program stored in the second recording medium (Otsuka, Col. 2 Lines 26 – 36).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Otsuka's portable terminal and their program recording mediums with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of preventing unauthorized access to sensitive data.

39. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milsted et al. U.S. Patent No. (6,345,256), Kataoka et al. U.S. patent No. (5,857,021), and Otsuka U.S. Patent No. (6,901,511), as applied to claim 16 and in further view of Kawamae et al. U.S. Patent No. (6,578,149).

40. As per claim 17, Milsted as modified fails to teach the second information processing apparatus is operable to transmit fourth information to the first information processing apparatus for confirming whether the third information processing apparatus is allowed to execute a program stored on the second recording medium. However, in an analogous art Kawamae teaches the second information processing apparatus is

operable to transmit fourth information to the first information processing apparatus for confirming whether the third information processing apparatus is allowed to execute a program stored on the second recording medium (Kawamae, Col. 1 Lines 60 – 64).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kawamae's method for reproducing data with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to find out which devices a network can trust by using authentication.

41. As per claim 18, Milsted as modified fails to teach the first information processing apparatus is operable to provide consent to the third information processing apparatus for the third information processing apparatus to execute a program stored on the second recording medium and the third information processing apparatus is operable to execute a program stored on the second recording medium when the third information processing apparatus receives the consent from the first information processing apparatus. However, in an analogous art Kawamae teaches the first information processing apparatus is operable to provide consent to the third information processing apparatus for the third information processing apparatus to execute a program stored on the second recording medium and the third information processing apparatus is operable to execute a program stored on the second recording medium when the third information processing apparatus receives the consent from the first information processing apparatus (Kawamae, Col. 1 Lines 60 – 64).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kawamae's method for reproducing data with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of being able to find out which devices a network can trust by using authentication.

42. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kataoka et al. U.S. patent No. (5,857,021) and in view of Uchiyama U.S. Patent No. (5,406,546).

43. As per claim 28, Milsted as modified fails to specifically teach the disk ID is recorded in the disk with an organic coloring matter. However, Uchiyama teaches the disk ID is recorded in the disk with an organic coloring matter (Uchiyama, Col. 7 Lines 57 – 68).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Uchiyama's magneto-optical recording medium with Milsted's automated method to package digital content for electronic distribution using the identity of the source content because it offers the advantage of having satisfactory values of push-pull signal level, radial contrast and C/N ratio (Umichyama, Col. 2 Lines 3 – 6).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Tolentino whose telephone number is (571) 272-2661. The examiner can normally be reached on 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques H. Louis-Jacque can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Roderick Tolentino
Examiner
Art Unit 2134

Roderick Tolentino

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